

REMARKS

Summary of Office Action

Claims 12, 14, 29, 31 and 37 stand rejected under 35 U.S.C.. § 102(b) as being anticipated by Murayama et al. (US 5,128,708).

Claims 2-6, 13, 15-16, 18-23, 30, 32-34, 38 and 41-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Murayama et al. in view of Honda et al. (US 5,296,884).

Applicant appreciates the Examiner's indication that claims 7-11, 24-28, 35, 36, 39 and 40 are allowed.

Summary of Response to the Office Action

Applicant has amended claims 2, 6, 12-13, 19, 23-24, 29-30, and 42-43 and added new claims 44-55 to further define the invention. Accordingly, claims 2-16 and 18-55 are pending for reconsideration.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 12, 14, 29, 31 and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Murayama et al. Applicant respectfully traverses these rejections.

Applicant respectfully submits that independent claim 12, as amended, recites an image processing method including in part, a step of "assuming said photographing scene by said camera information . . . said camera information . . . includes a message information relating to said photographing scene, . . . wherein said message information is audio information." Similarly, independent claim 29, as amended, recites an image processing apparatus including in part, "an assuming device which assumes said photographing scene by said camera information .

.. said camera information capturing devices captures message information .. wherein said message information is audio information.”

In contrast to the Applicant’s claimed invention, Murayama et al. entirely fails to teach or suggest message information that is audio information. As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Accordingly, Applicant respectfully submits that Murayama et al. fails to teach or suggest every element of at least independent claims 12 and 29, and thus, Murayama et al. fails to anticipate at least independent claims 12 and 29, and hence dependent claims 13, 14, 18, 30-31, and 33-34.

Furthermore, Honda et al. fails to overcome the deficiencies of Murayama et al. Honda et al. fails to describe, teach or suggest message information that is audio information. Accordingly, claims 12-14, 18, 29-31 and 33-34 are patentable over the art of record.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 2-6, 13, 15-16, 18-23, 30, 32-34, 38 and 41-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Murayama et al. in view of Honda et al. Applicant respectfully submits that independent claims 2 and 42, as amended, recite an image processing method including in part that image processing “is subjected to said digital image data in a first region limited to said specified first subject.” Similarly, independent claims 19 and 43, as amended, recite an image processing apparatus including in part, an image processing device that subjects imaging processing to “digital image data in a region limited to said specified

subject.” Applicant respectfully submits at least these features recited in amended independent claims 2, 19, 42, and 43 are neither taught nor suggested by Murayama et al. and Honda et al., whether taken singly or combined.

In contrast to Applicant’s claimed invention, Murayama et al. teaches color correction performed on the entire image being photographed. See Summary of the Invention of Murayama et al., col. 1, lines 56-61. Similarly, Honda et al. discloses a camera that is capable of recording an image and additional data. However, the camera processes the entire image, not a specified subject within the image. See Honda et al., col. 3, lines 34-41.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under “no obligation to submit evidence of nonobviousness,” such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because neither Murayama et al. nor Honda et al., whether alone or in combination, teach or suggest all the recited features of independent claims 2, . Namely, neither Murayama et al. nor Honda et al.

teach or suggest at least an image processing method including in part that image processing “is subjected to said digital image data in a first region limited to said specified first subject” as recited in independent claims 2 and 42 or Similarly, independent claims 19 and 43, as amended, recite an image processing apparatus including in part, an image processing device that subjects imagining processing to “digital image data in a region limited to said specified subject.”

As pointed out in M.P.E.P. § 2143.03, “[t]o establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) should be withdrawn because Murayama et al. and Honda et al. do not teach or suggest each and every feature of independent claims 2, 19, 42 and 43.

Additionally, Applicant respectfully submits that dependent claims 3-6, and 20-23 also are allowable insofar as they recite the patentable combinations of features recited in claims 2 and 19, respectively, as well as reciting additional features that further distinguish over the applied prior art.

New Claims 44-55

Applicant adds new claims 44-55 to further define the subject matter of the current invention. Thus, Applicant respectfully requests consideration of newly added claims 44-55.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests entry of the amendments to place the application in clear condition for allowance. Moreover, the amendments do not raise new issues for search or examination. Therefore, Applicant respectfully requests reconsideration of the application and timely allowance of pending claims 2-16 and 18-55. The Examiner is invited to contact the undersigned by telephone if any issues remain unresolved.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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